

R E M A R K S

In response to the Office Action mailed October 7, 2002, Applicant submits this Amendment concurrently with a Petition for a Two-Month Extension of Time.

Claims 1-2, 4, and 6-18 were pending in this application. In the Office Action, the Examiner rejected Claims 1-2, 4, and 6-18. The Examiner objected to the specification. By this Amendment, Claim 4 has been amended, Claims 19-20 have been added, and the specification has been amended. The foregoing amendments and the following remarks are believed to be fully responsive to the Office Action and are believed to place the above-identified application in condition for formal allowance.

Further examination and reconsideration of the rejection are hereby requested.

Objections

The Examiner has objected to the use of trademarks in the paragraph on page 8, lines 11-19 of the specification. Reconsideration and withdrawal of the rejection is requested.

It is respectfully submitted that the varnishes which may be used in accordance with the present invention are entirely conventional in the art. "It is well settled that the disclosure of an application embraces not only what is expressly set forth in words or drawings, but what would be understood by persons skilled in the art."<sup>1</sup> The specific varnishes provided on page 8 of the specification are mere examples of

commercial products which are available and useful in the practice of the invention, rather than having any particular significance in the context of the invention as claimed. Furthermore, it is submitted that by specifying trade names, the varnishes are disclosed in a way which would allow the invention to be put into practice most easily, and further information concerning the composition of each varnish is believed to be irrelevant in this regard.<sup>2</sup>

With respect to the percentages provided in the specification, it is submitted that one skilled in the art would readily understand that the percentages are by weight.

With respect to the term “polefin” in the specification (page 8, line 13), it is submitted that due to a minor typographical error, the term “polefin” should read “polyolefin.” The specification has been amended in this manner. It is requested that this objection be withdrawn.

Claim Rejections - 35 U.S.C. §112, Second Paragraph

Claim 4 was rejected under 35 U.S.C §112, second paragraph, as being indefinite. Claim 4 has been amended to refer to a release strength factor of between 17 grams force / 50 mm and 30 grams force / 50 mm. This range originally appeared in Claim 4. However, the upper limit of the range was inadvertently omitted in the

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1 In re Chilowsky, 43 CCPA 775, 780, 229 F.2d 457, 460, 108 USPQ 321, 324 (1956)

2 Although this has not been verified by Applicants, as trade marked products, the compositional details of each varnish are often proprietary and therefore quite possibly not readily available.

amendment to Claim 4 in Applicant's previous response. Claim 4 has been amended to include the release factor range. Withdrawal of this rejection is requested.

Claim Rejections - 35 U.S.C. §112, First Paragraph

Claims 1, 4, and 6-9, and 11-18 were rejected under 35 U.S.C §112, first paragraph, as based on a disclosure which is not enabling. In particular, the Examiner has objected to the recitation of "material having a density less than the polyester."

To be enabling under §112, a patent specification must disclose sufficient information to enable those skilled in the art to make and use the claimed invention ... If an invention pertains to an art where the results are predictable, e.g., mechanical as opposed to chemical arts, a broad claim can be enabled by disclosure of a single embodiment.<sup>3</sup>

It is submitted that, with respect to enablement under §112, first paragraph, the specification provides sufficient information to one skilled in the art to make and use the claimed invention. As the Examiner has stated, "it is well within the ordinary skill of the art to select a suitable material having a density less than polyester." (See paragraph 7, page 4 of the Official Action), and thus the selection of a material based on a basic mechanical property, such as density, may be considered predictable. Moreover, the specification provides ample discussion of material suitable for use in the

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<sup>3</sup> *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed.Cir.), cert. denied, 484 U.S. 954 (1987). Applicant's representative has reviewed *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976), and has not been able to ascertain the applicability of this case to the present rejection. In *In re Mayhew*, the court affirmed the rejection of claims which failed to recite elements that were considered essential to the invention. In the present Official Action, the Examiner has not suggested here that essential elements have been excluded from the claims.

claimed invention which has a density less than the polyester. For example, and without limitation, the specification on page 3, lines 4-5, and page 5, lines 25-29 provides such enabling disclosure. It is thus believed that "material having a density less than the polyester" is enabled by the present application, and it is requested that the rejection under 35 U.S.C. §112, first paragraph, be withdrawn

Claim Rejections - 35 U.S.C. §103

Claims 1, 2, 4 and 6-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Canadian Patent Application 2,172,237. This rejection is respectfully traversed.

In order to establish a case of prima facie obviousness, the prior art reference must teach or suggest all of the claim limitations. Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, *not applicant's disclosure*.<sup>4</sup>

The Canadian Patent Application describes a single layer label 20 which has a low tack adhesive 21. With regard to Claim 1, the Canadian Patent Application does not describe all of the claim elements, and does not provide a motivation to make the modification proposed by the Examiner. The Examiner states that the Canadian Patent Application does not provide "a teaching of the material which constitutes the 'second layer.'" More particularly, the Canadian Patent Application neither discloses nor

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<sup>4</sup> *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

suggests “a second layer including material having a density less than the polyester for presenting information at the major surface of the label,” as recited in Claim 1.

The Examiner also fails to provide sufficient motivation to make the proposed modification. The Examiner states, as quoted above, that “it is well within the ordinary skill of the art to select a suitable material having a density less than polyester.” However, a statement that a modification is well within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teaching of the references.<sup>5</sup> (See also MPEP 2143.01.) Here, the Examiner has provided no reason, absent hindsight, why one skilled in the art would modify the device described in the Canadian Patent Application to include a second layer as claimed by Applicant in Claim 1. Accordingly, Claim 1 is not obvious over the Canadian Patent Application. Claim 2 depends from Claim 1, and is believed allowable at least for the reasons discussed above concerning Claim 1.

Claim 4 recites “the second layer includes material having a density less than the polyester.” Claim 4 is not believed obvious in view of the Canadian Patent Application. In particular, the Canadian Patent Application does not disclose or suggest any structure analogous to a second layer which includes material having a density less than the polyester. Moreover, the Canadian Patent Application provides no motivation to select a second material having a lower density than polyester. Accordingly, Claim 4 is not obvious in view of the Canadian Patent Application and thus allowable. Claims 6-18

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<sup>5</sup> *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

depend from Claim 4, and are believed allowable at least for the reasons discussed above concerning Claim 4.

Accordingly, it is requested that the rejection under 35 U.S.C. §103(a) in view of the Canadian Patent Application be withdrawn.

Claims 1, 2, 4 and 6-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over WO 98/41966. This rejection is respectfully traversed.

It is submitted that the Examiner has not made a *prima facie* case of obviousness. With regard to Claim 1, WO 98/41966 does not describe all of the claim elements. WO 98/41966 describes a label, e.g., label 19, which includes two layers, e.g., first layer 23 and second layer 25. However, WO 98/41966 neither discloses nor suggests that the two layers may have different density properties. In particular, WO 98/41966 neither discloses nor suggests “a second layer including material having a density less than the polyester for presenting information at the major surface of the label,” as recited in Claim 1. Accordingly, Claim 1 is not believed obvious over the Canadian Patent Application. Claim 2 depends from Claim 1, and is believed allowable at least for the reasons discussed above concerning Claim 1.

Claim 4 recites “the second layer includes material having a density less than the polyester.” Claim 4 is not believed obvious in view of WO 98/41966, which does not disclose or suggest any structure analogous to a second layer which includes material having a density less than the polyester. Accordingly, Claim 4 is not obvious in view of the Canadian Patent Application and allowable. Claims 6-18 depend from Claim 4 are believed allowable at least for the reasons discussed above concerning Claim 4.

Accordingly, it is requested that the rejection under 35 U.S.C. §103(a) in view of WO 98/41966 be withdrawn.

#### New Claims

New Claims 19-20 have been added. Support for Claims 19-20 is provided throughout the specification, and particularly, at page 2, lines 6-9 and page 7, lines 12-22.

Claims 19 and 20, which depend from Claim 1 and Claim 4, respectively, each recite “wherein the second layer is formed of a material having a density and softness less than the polyester, to allow the second layer to be cut or scored so as to define the removable portion, without compromising the integrity of the first layer.”

It is believed sufficiently enabling to further define the material of the second layer as having a softness less than the polyester to allow the second layer to be cut or scored so as to define a removable portion, without compromising the integrity of the first layer. It is submitted a person skilled in the field of manufacturing labels would readily be able to identify a suitable second material having the defined properties.

As indicated above, the effect of the defined relative softness of the polymeric material is such that it may be cut or scored (so as to define the removable portion) without compromising the integrity of the first layer. This relationship between the materials of the first and second layers is clearly disclosed in the present specification at page 2, lines 6-9 and page 7, lines 12 to 22. These passages make reference to using polypropylene as the material of the second layer but it is believed that one skilled in the art would appreciate that the relationship between the first and second layers may be

achieved with other materials provided the softness relationship between the materials of the first and second layers is maintained.

Claims 19-20 are believed allowable over the art of record. The resultant composite layer provides a significant advance in marketing and promotional stock. For example, none of the cited prior art discloses or suggests a second layer that is formed of a material having a density and softness less than the polyester, to allow the second layer to be cut or scored so as to define the removable portion, without compromising the integrity of the first layer. The prior art of record does not disclose or suggest labeling having different layer material properties, to achieve the advantages of the new claims 19-20. For these reasons, allowance of Claims 19-20 is believed warranted and is requested.

#### Conclusion

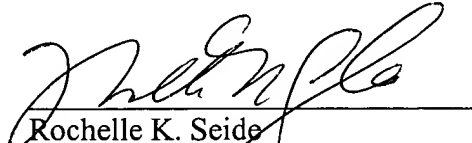
Attached is a marked-up version of the changes made by the Applicant. The attached pages are captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."



PATENT

In view of the foregoing, Claims 1-2, 4 and 6-20 are believed allowable, and this application is believed to be in condition for formal allowance. Prompt and favorable allowance is requested.

Respectfully submitted,

  
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**APPENDIX A****VERSION WITH MARKINGS TO SHOW CHANGES MADE**

In the Specification:

Amend the paragraph on page 8, lines 11-19 as follows:

-- A suitable varnish was formed utilizing the following components:

- LABELSTAR™ 2540 varnish 11132144 is a slip varnish (C.O.F.)  
Modified STARPAC™ AS3 varnish 11006151. This was achieved by  
an addition of 1.2% of [polefin] polyolefin wax to STARPAC™ AS3  
varnish 11006151.
- synthetic silicone alternate. 0.1%
- glassene silicone alternate 0.99%
- plasticiser agent 0.5%
- polyester waxing agent 1.23%  $\pm$  0.3%
- emulsifier 2.0% + 0.6% --

In the Claims:

Amend Claim 4 as follows

-- 4. (Twice Amended) A composite label including a first layer for displaying information at a first major surface of the label, and a second layer including a removable portion arranged so as to be separated from the label and secured to another object, wherein the second layer includes an adhesive on one side thereof for securing the removable portion to the first later and the first layer includes a release coating to

facilitate removal of the portion therefrom, the adhesive and release coating providing a release strength factor of between 17 grams force / 50 mm and 30 grams force / 50 mm, and wherein the first layer is formed of polyester and the second layer includes material having a density less than the polyester. —

Add the following new Claims 19 and 20:

-- 19. (New) A composite label as claimed in claim 1, wherein the second layer is formed of a material having a softness less than polyester, to allow the second layer to be cut or scored so as to define the removable portion, without compromising the integrity of the first layer.—

-- 20. (New) A composite label as claimed in claim 4, wherein the second layer is formed of a material having a softness less than polyester, to allow the second layer to be cut or scored so as to define the removable portion, without compromising the integrity of the first layer.--